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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/324,511	06/03/1999	HARUHISA SUZUKI	35.G2398	1647
5514	7590	11/04/2005		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER O'CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/324,511

**Applicant(s)**

Suzuki et al.

**Examiner**

O'Connor

**Art Unit**

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on August 8, 2005 (RCE) and July 19, 2005 (Amdt).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 66, 68, 70, and 76 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 66, 68, 70, and 76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on June 3, 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 19, 2005 has been entered.

### ***Preliminary Remarks***

2. This Office action responds to the amendment and arguments filed by applicant on July 19, 2005 in reply to the previous Office action on the merits, mailed May 3, 2005.

3. The amendment of claims 66, 68, and 70 by applicant in the reply filed July 19, 2005 is hereby acknowledged.

4. The addition of claim 76 by applicant in the reply filed July 19, 2005 is hereby acknowledged.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 66, 68, 70, and 76 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiota et al. (US 6,324,521).

Shiota et al. disclose a system and method for providing a plurality of services over a network 5, comprising the steps of: storing, by a service center 2 items and their prices in a first table; storing, by the service center, a group having a plurality of service providers 3, 4, associated with at least one common item in a second table; it being inherent that the stored prices would be updated by the service center to reflect new prices as the prices change over time; requesting, by a user terminal, to the service center to provide an item from one of the plurality of the service providers; referring, by the service center, to the second table to

determine service providers in a group associated with the requested item; referring to the updated first table on the basis of a result of referring to the second table; calculating a charge related to the request on the basis of a result of referring to the first table; sending a notification from the service center 2 to the user 1 terminal 6, the notification including the charge calculated in the calculating step; forwarding the request from the user 1 terminal 6 to an appropriate service provider 3, 4, via the network 5 automatically upon a confirmation instruction from the user 1 terminal 6 of whether to provide the item; and, performing, by the appropriate service provider 3, 4, producing the item according to the forwarded request.

Regarding claim 76, in the system and method of Shiota et al. the item requested by the user terminal is obtained, by the service provider, by printing an image stored in the service center on a storage medium.

### ***Response to Arguments***

7. Applicant's arguments filed July 19, 2005 have been fully considered but they are not persuasive.

8. Regarding the argument that Shiota et al. fail to disclose storing items and their prices in a first table, Shiota et al. indeed store items and their prices in a first table. Obviously, without doing so, Shiota et al. would be unable to calculate the correct/appropriate charges because the prices would be unknown to the system.

9. Regarding the argument that Shiota et al. fail to disclose storing a group of service providers associated with at least one common item of the first table, in a second table, Shiota et al. indeed disclose storing a group of service providers associated with at least one common item of the first table, in a second table. Otherwise, Shiota et al. would not know which providers provided which services. Also, see, for example, claim 1, lines 2-4 and 9-12 referring to the group of service providers.

10. Regarding the argument that Shiota et al. fail to disclose updating the prices of the items in the first table, one of ordinary skill in the art would instantly recognize that the method and system of Shiota et al. would necessarily, thus inherently, update the prices of the items stored in the first table in order to reflect new prices as the prices changed over time.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to the disclosure.

12. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is (571) 272-6787, and whose facsimile number is (571) 273-6787.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at (571) 272-6771.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

October 27, 2005



10/27/05

Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627